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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,295	10/02/2000	Mathias Entenmann	35901.3	4137

27683 7590 03/19/2009

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ART UNIT	PAPER NUMBER
3694	

MAIL DATE	DELIVERY MODE
03/19/2009	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/678,295
Filing Date: October 02, 2000
Appellant(s): ENTENMANN, MATHIAS

Joseph R. Mencher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on February 12, 2009 appealing from the Office action mailed February 4, 2008.

This response vacates the Communication mailed September 11, 2008, and acknowledges the Reply Brief dated August 18, 2008 in accordance with MPEP § 1208, part II.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,608,778	Partridge, III	03-1997
6,142,369	Jonstromer	11-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: The rejections are copied from the Final Office Action mailed on February 4, 2008.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 7, 9-10, 12-19, and 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partridge, III (U.S. Patent No. 5,608,778) ("Partridge") in view of Jonstromer (U.S. Patent No. 6,142,369) ("Jonstromer").

> Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

3. **Regarding claim 1,** Partridge discloses a method of effecting a cashless payment transaction by means of a merchant station characterized by a merchant station identification code, a mobile cell phone with a SIM card characterized by an identification code identifying the SIM card, and a comparing device, which comprises a transaction data memory device, a merchant checking device for checking the identification codes of the merchant stations authorized for this method, and a subscriber checking device for checking the identification codes of the SIM cards authorized for this method and which is connected to account keeping device (see figure 1, col. 1, lines 34-10 of col. 2), comprising the steps:

reading an amount of money to be paid into the merchant station (see col. 3, lines 18-22, col. 4, lines 5-15, figure 2/element 12,),

transmitting, by the merchant station, the identification code of the merchant station and at least the amount of money to the comparing device through a data link (see col. 5, lines 3-5, figure 2/element 18, col. 3, lines 36-23 of col. 7),

checking the authority of the merchant station for the method, using the merchant checking device (see figure 2/element 14, col. 3, lines 36-23 of col. 7),

terminating the method in the absence of the authority, otherwise writing the data as an open transaction into the transaction memory device of the comparing device (see figure 2/element 17, col. 3, lines 36-23 of col. 7),

after the step of reading the amount of money into the merchant station, making a connection from the mobile cell phone to the comparing device (see figure 2/element 14, col. 3, lines 36-23 of col. 7),

transmitting the identification code of the merchant station and the identification code associated with the SIM card from the mobile cell phone to the comparing device (see figure 2/elements 14, 17; col. 3, lines 36-23 of col. 7 and **note** below),

checking the authority of the SIM card for the method, using the subscriber checking device, in the absence of the authority terminating the method, clearing the open transaction from the transaction memory and the transmitting corresponding data to the merchant station, otherwise comparing the merchant station identification code transmitted from the mobile cell phone with those of the open transactions stored in the transaction memory device and on failure to find such a transaction terminating the process and, on finding the transaction (see figure 2/element 17, col. 3, lines 36-23 of col. 7),

transmitting the transaction data to the mobile cell phone (see col. 2, lines 40-23 of col. 7, figure 2),

outputting the data through the mobile cell phone (see col. 2, lines 40-23 of col. 7, figure 2),

requesting confirmation information through the mobile cell phone (see col. 2, lines 40-23 of col. 7, figure 2),

transmitting the confirmation data to the comparing device (see col. 2, lines 40-23 of col. 7, figure 2),

terminating the transaction and clearing the transaction from the transaction memory if the confirmation data corresponds to a refusal, and transmitting the transaction data from the transaction memory and the identification code of the mobile

cell phone to an account keeping device and clearing the transaction from the transaction memory in the alternative case (see col. 2, lines 40-23 of col. 7, figure 2); and

transmitting additional supplementary transaction data to the comparing device or mobile cell phone from the merchant station (see col. 2, lines 40-23 of col. 7, figure 2).

Partridge teaches electronic financial transaction authentication using cellular phone, but it does not expressly teach a cellular phone with a SIM card. However, Jonstromer teaches a cellular phone with a smart card (or SIM card) for conducting electronic financial transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jonstromer, relating to electronic financial transactions using a SIM card, with the teachings of Partridge, relating to electronic financial transaction authentication via cellular phone, to offer an improved system to customers as described in Partridge (see col. 9, lines 15-21).

Note: The Examiner believes that a combination of Partridge and Jonstromer discloses Applicant's invention and the major argument specified in the Applicant's amendment, page 11, 2nd paragraph which states "transmitting or receiving the identification code of the merchant station and the identification code of the SIM card from mobile cell phone to the comparing device".

8. **Regarding claim 2,** Partridge teaches a method according to claim 1, characterized in that the merchant station and the cell phone have interfaces for

wireless transmission of data from the merchant station to the cell phone, and in that the identification code of the merchant station is transmitted to the mobile cell phone through these interfaces for wireless transmission before the mobile phone connection to the comparing device is made, and in that the identification code stored there can be transmitted during the existence of the connection to the comparing device (see col. 5, lines 1-5).

9. **Regarding claims 9-10,** Partridge teaches a method according to claim 2, characterized in that at least one of the wireless interfaces is an infrared interface, and a microwave interface (see col. 1, lines 11-30).

10. **Regarding claim 12,** Partridge teaches a method according to claim 1, characterized in that when one of the necessary connections cannot be made, the transaction is terminated and if required the corresponding, stored open transactions in the transaction memory of the comparing device are cleared (see figures 2-6, col. 2, lines 40-23 of col. 7).

11. **Regarding claim 13,** Partridge teaches a method according to claim 1, characterized in that the identification codes are replaced by the corresponding data identifying the account before transmission to the account keeping devices (see figures 2-6, col. 2, lines 40-23 of col. 7).

12. **Regarding claim 14,** Partridge teaches a method according to claim 1, characterized in that, when no connection can be made to the merchant station or the mobile cell phone, at least one further attempt is made to make this connection and the process is only then terminated (see figures 2-6, col. 2, lines 40-23 of col. 7).

13. **Regarding claim 15,** Partridge teaches a method according to claim 1, characterized in that when one of the connections cannot be made, a communication is given to the merchant station or the mobile cell phone, before the procedure is terminated (see figures 2-6, col. 2, lines 40-23 of col. 7).

14. **Regarding claims 16-17,** Partridge does not expressly teach SIM card feature. However, Jonstromer teaches electronic financial transaction using a SIM card (see Jonstromer, col. 1, lines 45-59 of col. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Jonstromer, relating to electronic financial transactions using a SIM card, with the teachings of Partridge, relating to electronic financial transaction authentication via cellular phone, to offer an improved system to customers as described in Partridge (see col. 9, lines 15-21).

15. **Regarding claims 3, 4, 7, and 23-31,** these claims are similar to claims 1, 2, 9, 10, and 12-17. They have same elements and limitations. Hence, they are rejected under the rationale provided in claims 1, 2, 9, 10, and 12-17.

Regarding claims 18, 19, 22 and 32, these are the system claims for implementing the method claims 1-4, 7, 9-10, 12-17, and 23-31. They have the same steps and limitations. Hence, they are rejected under the rationale provided in claims 1-4, 7, 9-10, 12-17, and 23-31.

(10) Response to Argument

Independent claim 1

The Appellant argues:

1). Transmitting an amount of money from the Merchant Station

The Appellant argues that Partridge reference does not disclose that an amount of money is transmitted from the Merchant.

- The Examiner disagrees. The Examiner would like to point the Appellant to column 5, lines 6-10 and Figure 3 (line with TP, ESN, MIN1, MIN2 from merchant to Credit Center) of Partridge. Lines 6-10 states that:

> "The customer press into telephone 10 a prefix, such as "*9", the merchant's ID code, and the sum of money that should be charged to the customer's account and credited to the merchant. That forms the string MIN2."

and Figure 3 clearly shows that string MIN2 is transmitted from the Merchant. In addition, Figure 2 and description in column 5, lines 27-28 describes that "therefore, center 40 is in a position to evaluate whether the customer of MIN1 deserves to get credit". It is clearly explained that the role of the Credit Center is to evaluate the information they receive to determine if a credit should be granted. Hence, it is interpreted that the Credit Center will evaluate the information of MIN2 when they receive it to determine if a credit should be granted. The Examiner is satisfied that this description explains clearly what the Credit Center does with the information of MIN2. Therefore, the Examiner considers this limitation is disclosed in the Partridge reference.

2). Transmitting the identification code of the merchant from both of the Merchant station and the Mobile Cell Telephone

The Appellant argues that Partridge discloses transmitting the merchant ID code from either the Merchant or the Telephone, and that this teaches away from transmitting it from both.

- The Examiner disagrees. The Examiner would like to point the Appellant to the column 5, lines 6-10 and Figure 3 of Partridge where it clearly shows that the string MIN2 is transmitted both from the Merchant to Credit Center and from the Cellular Telephone (via the Base Station) to the Credit Center. Therefore, the Examiner considers this limitation is disclosed in the Partridge reference.

3). Writing the data transmitted from the Merchant Station to an open transaction and then comparing a Merchant Station identification code transmitted from the Mobile Cell Telephone with the open transaction to find the transaction

The Appellant argues that because there is no disclosure in Partridge that the merchant ID code is transmitted from both the Merchant and the Telephone, and thus there is no disclosure of writing the data transmitted from the Merchant station for comparison with the mobile telephone.

- The Examiner disagrees. Figure 3 of Partridge clearly shows that the merchant ID code (see string MIN2) is transmitted from both the Merchant and the

Cellular Telephone, and the transmission also includes other data for process (i.e. TP, ESN, MIN1). Therefore, the Examiner considers this limitation is disclosed in the Partridge reference.

4). Transmitting the transaction data to the Mobile Cell Telephone and outputting the data through the Mobile Cell Telephone

The Appellant argues that Partridge discloses that the only information sent to the telephone is an approval code or a decision to grant credit, and there is no disclosure for transmitting the transaction data to Mobile Cell Telephone and outputting the data through the Mobile Cell Telephone.

- With respect to transmitting the transaction data to the Mobile Cell Telephone, Partridge teaches transmitting the approval code but does not explicitly disclose transmitting the transaction data. However, the transaction data is the additional data and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Partridge to include the additional data in the approval code and transmits it to the Mobile Cell Telephone for further process and as Partridge's invention is equipped for transmitting data, no unpredicted result is expected.

Even if the Appellant disagrees with the Examiner's conclusion that Partridge does not teach transmitting the transaction data. Appellant is reminded that the claim is rejected under 35 U.S.C. 103 and that the second reference (Jonstromer) teaches transmitting the confirmation information, the transaction data, and that a combination of

the Partridge and Jonstromer references would have disclosed the Appellant's claimed limitation (see Jonstromer, column 6, lines 29-34, 43-47).

- With respect to outputting the data through the Mobile Cell Telephone, the Examiner notes that Jonstromer reference discloses an electronic transaction system for conducting electronic financial transactions with a mobile phone and an electronic till where the phone is equipped with a visual display unit (VDU) and keypad for displaying and entering data (see Figure 1 and description). The Examiner notes this VDU is equivalent to the outputting data of the claimed invention because a consumer can view the data he enters and receives from the VDU. Column 6, lines 30-34 of Jonstromer clearly states that the transmitted information includes "payer's bank account; payer's electronic signature; payer's bank account; and the amount to be transferred."

And lines 43-47 say "The electronic banking terminal may also transmit a signal to the smart card 4, confirming completion of the transaction. This signal may be stored in the form of an electronic receipt on the payer's smart card electronic wallet." Here, it says clearly that a signal containing the transaction data and the completion of the transaction is transmitted to the smart card of the mobile telephone. Since the signal is transmitted to the smart card of the mobile telephone, the Examiner interprets that the information transmitted can be displayed on the VDU of the mobile telephone. The Examiner is satisfied that a combination of the Partridge and Jonstromer references discloses this limitation.

5). Requesting confirmation information through the Mobile Cell Telephone and transmitting the confirmation data

The Appellant argues that there is no disclosure of requesting confirmation information through the mobile cell telephone and transmitting the confirmation data.

- With respect to requesting confirmation information through the Mobile Cell Telephone, the Examiner would like to point the Appellant to column 4, lines 8-10 and Figure 2 of Partridge where it says clearly the cellular telephone requests confirmation by sending the AUTHR string together with the RAND, ESN and MIN1 strings for confirmation. In addition, the Examiner would like to point the Appellant to the description of Jonstromer, column 6, lines 19-34 where it says:

"When the owner of a smart card electronic wallet wishes to arrange a credit transfer from his bank account to a payee's account, he inserts the smart card electronic wallet 7, into a mobile phone 4, and enters his PIN using the mobile phones keypad 5. In response to a menu driven series of options and questions generated by the smart card and displayed on the mobile phones VDU 6, the owner enters details of his own bank account and his bank's address, (this information may be pre-stored on the smart card), the amount of money to be transferred and the payee's bank account number. This information is used to formulate a signal containing the following data: payer's bank account; payer's electronic signature; payer's bank account; and the amount to be transferred."

And lines 44-47 say:

"The electronic banking terminal may also transmit a signal to the smart card 4, confirming completion of the transaction. This signal may be stored in the form of an electronic receipt on the payer's smart card electronic wallet."

The Examiner is satisfied that a combination of the Partridge and Jonstromer references discloses the limitation as claimed

- With respect to transmitting the confirmation data, the Examiner considers this argument is the same as the argument in # 4 (see transaction data argument above), and therefore it is not repeated here. The Examiner is satisfied that this argument has been answered in the # 4 argument above.

6). Transmitting additional supplementary transaction data from the Merchant Station

The Appellant argues that there is no disclosure in Partridge for transmitting additional transaction data from the Merchant station.

- The Examiner disagrees. The Examiner would like to point the Appellant to Figures 3 and 4 where they clearly show the Merchant sends different data including the TP, ESN, MIN1, MIN2, RAND and AUTHR strings to the Credit Center. The Examiner considers this element is disclosed in Partridge reference.

The claim is rejected under 35 U.S.C. § 103 as obvious over the Partridge reference in view of the Jonstromer reference.

Partridge teaches electronic financial transaction authentication using a cellular telephone. Partridge teaches using various encryption codes and data for process, such as: merchant ID code (MIN2), random sequence (RAND), equipment number (ESN), cell phone assigned number (MIN1), shared secret data (SSD which is divided into two strings, SSDA (authentication) and SSDB (communication encryption), TP (transaction password), CGSA (geographic service area), AUTHR (Authorization), and MIN2 (merchant ID code and sum of money data).

The difference between Partridge and the claimed invention is that Partridge does not explicitly disclose a cellular phone with a SIM card. A SIM card is short for **S**ubscriber **I**dentity **M**odule card and contains chips that store a subscriber's personal identifier, billing information, and data (names, phone numbers, etc.). A SIM card can be enhanced for **G**lobal **S**ystem for **M**obile (GSM) to allow web browsing and data transfer options.

Jonstromer teaches an electronic transaction system for conducting electronic financial transaction using a smart card. Per Jonstromer, a SIM card can carry a variety of information about a mobile phone subscriber and the service he/she is entitled to access (see column 1, line s 30-32), access to smart card is controlled by a PIN (see column 2, lines 14-15), and a smart card may be adapted and arranged to act as a SIM card and insert into a mobile phone (see column 2, lines 27-29).

One of ordinary skill in the art of electronic financial transaction at the time of the invention would have found it obvious to update the cellular telephone device of Partridge using the more advanced SIM card, as taught by Jonstromer, in order to gain

the benefits of such adaptation, such as increased information storage and better security. As both Partridge and Jonstromer are in the same art of electronic financial transaction, all this would have accomplished with no unpredictable results.

In conclusion, the Examiner is satisfied that all the limitations the Appellant argues for claim 1 are disclosed in the Partridge and Jonstromer references. The Examiner further determines that a combination of Partridge and Jonstromer discloses the Appellant's invention as claimed.

Independent claim 3

The Appellant argues that Partridge does not disclose, in addition to the recitations in claim 1, terminating the transaction if the confirmation information is not given within a predetermined time.

- The Examiner disagrees. Partridge teaches that the transaction terminates successfully when the request is authorized (see column 2, lines 1-3). The Examiner interprets this as that the transaction would be terminated as well if the request is not authorized. In addition, Jonstromer teaches that the confirmation information is sent to the smart card confirming the completion of the transaction (see column 6, lines 44-47). Therefore, the Examiner is satisfied that a combination of Partridge and Jonstromer discloses this limitation.

Independent claim 18

The Appellant argues that Partridge reference does not disclose, in addition to the recitations in claim 1, a control device that compares the identification code of the Merchant Station.

- The Examiner disagrees. Figure 1/element 42 (processor), Figures 2 and 3/lines 15 & 16 of Partridge teach that the Credit Center receives and compares information (see column 5, lines 29-32 "When credit center 40 determines … as well (lines 15 and 16 in Figures 2 and 3)") including the merchant ID code (see column 5, lines 6-9 "the merchant's ID code … That forms the string MIN2"). The Examiner interprets that the Credit Center's processor 42 as taught by Partridge is the same as the control device in Appellant's invention.

Independent claim 19

The Appellant argues that Partridge reference does not disclose, in addition to the recitations in claim 1, a control device transmits the transaction data to Mobile Cell Telephone and sends a request for confirmation to this, and receives the confirmation data.

- The Examiner disagrees. Figure 1/elements 10, 30, 40, 42 of Partridge teach that the Credit Center transmits and receives the transaction data including the confirmation data (see column 6, lines 51-60 "Preprocessor 42 confirms the bona fide of

the user requesting credit … Its decision is then communicated to equipment 30 and , optionally, to wireless telephone 10"). The Examiner interprets that the Credit Center's processor 42 as taught by Partridge is the same as the control device in Appellant's invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hai Tran/

Examiner, Art Unit 3694

Conferees:

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694

/Mary Cheung/

Primary Examiner, Art Unit 3694